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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------------|
| 10/657,287 | 09/08/2003 | William A. Clark | 092807.011000 | 1382 |
| 33717 7590 12/18/2007 GREENBERG TRAUIG LLP (LA) 2450 COLORADO AVENUE, SUITE 400E INTELLECTUAL PROPERTY DEPARTMENT SANTA MONICA, CA 90404 | | | EXAMINER CALLAHAN, PAUL E | |
| | | | ART UNIT 2137 | PAPER NUMBER |
| | | | MAIL DATE 12/18/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/657,287 | Applicant(s) CLARK ET AL. | |
| | Examiner Paul Callahan | Art Unit 2137 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15, 17-20 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 12, 17-20 and 25-28 is/are allowed.
- 6) ☒ Claim(s) 8, 13-15, and 23 is/are rejected.
- 7) ☒ Claim(s) 10, 11 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action, when taken together with the changes made to the language of the claims via the after-final amendment filed December 14, 2007 is persuasive and, therefore, the finality of that action is withdrawn.

2. Claims 1-34 were pending at the time of the previous Office Action, mailed September 19, 2007. By the latest amendment claims 1-7, 16, 21, 22, and 29-34 are cancelled. Therefore claims 8-15, 17-20, and 23-28 are pending and have been examined.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8, 13-15, and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Ryota, International Application EP 0 899 688 A3, and Antonellis et al., US 7,206,409 (Submitted with the Applicant's IDS).

As for claim 8, Ryota teaches a moving picture security code application system (Para. 57) comprising: (a) code symbol recording equipment for recording code symbols on a moving picture record medium (fig. 2; [0001], [0033]), and (b) a control system for controlling said recording equipment to cause it to record on said record medium (fig. 2, [0023]) information comprising a plurality of separate coded symbols ([0043], [0049]), each being recorded in a separate frame of said moving picture ([0033], [0034], [0035]). Ryota fails to explicitly teach each symbol representing a digit of a multi-digit security code. However, Antonellis does teach this feature (col. 3 lines 10-20, col. 6 lines 12-34, 55-63, col. 7 lines 45-50, col. 10 lines 30-44). Ryota fails to teach that each of said symbols is composed of one or more small marks made to look like a defect selected from the group consisting of dirt or dust particles; scratches; and color defects. However, Antonellis does teach this feature (col. 7 lines 5-10). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Ryota. It would have been desirable to do so since this would increase the fidelity of the watermarking process and prevent unauthorized removal of the mark.

As for claim 13, the combination of Ryota and Antonellis fails to explicitly teach a system as in claim 8 in which said recording equipment includes fiber-optic cables with an exit focusing lens and a controlled light source for sending light through selected ones of said fiber-optic cables to record a pattern of light spots on said record medium and thereby form one of said symbols. However, Official Notice may be taken that that

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use of such features in recording equipment is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Ryota. It would have been desirable to do so since this would allow for the use of standard film recording apparatus to encode the watermarked code symbols.

As for claim 14, the combination of Ryota and Antonellis does not explicitly teach a system as in Claim 13 in which said recording equipment includes means for synchronizing the formation of said spots with the movement of said record medium through a copy recorder for recording medium. However, Official Notice may be taken that that use of such features in recording equipment is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Ryota. It would have been desirable to do so since this would allow for the use of standard film recording apparatus to encode the watermarked code symbols.

As for claim 15, Ryota teaches a system as in Claim 14 in which said record medium is motion picture film and said copy recorder is a film printer (fig. 2; [0001], [0033]).

As for claim 23, Ryota teaches a motion picture film print bearing coded information (fig. 2; [0001], [0033]), said coded information being represented by a

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plurality of small marks having the appearance of defects formed into code symbols representing said coded information defects ([0051]: a magnifying glass must be used to discern that the mark is a coding symbol). Ryota fails to teach that each of said symbols is composed of one or more small marks made to look like a defect selected from the group consisting of dirt or dust particles; scratches; and color defects.

However, Antonellis does teach this feature (col. 7 lines 5-10). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Ryota. It would have been desirable to do so since this would increase the fidelity of the watermarking process and prevent unauthorized removal of the mark.

Allowable Subject Matter

5. Claims 9, 12, 17-20, and 25-28 are allowed.
6. Claims 10, 11, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent document teaches systems of marking film by methods pertinent to the Applicant's disclosure:

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Tanaka 3,867,030

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



/Paul Callahan/
December 14, 2007


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER